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MAILED

FEB 08 2011

OFFICE OF PETITIONS

In re Patent of Stephen Madigan et al. :  
Patent No. 7,070,541 :  
Issue Date: July 4, 2006 :  
Application No. 10/824,963 :  
Filing Date: April 15, 2004 :  
For: Educational Tracks and Apparatuses :

Decision on Petition

This is a decision on the petition under 37 C.F.R. § 1.378(b), filed September 13, 2010, to reinstate the above-identified patent.

The petition is **DISMISSED**.

Facts

The patent issued July 4, 2006.

The 3.5 year maintenance fee could have been paid from July 4, 2009, to January 4, 2010, or with a surcharge from January 5, 2010, to Tuesday, July 6, 2010. The fee was not timely paid. As a result, the patent expired on July 5, 2010.

The instant petition was filed September 13, 2010.

The petition is signed by Winifred Madigan, one of the inventors. The other inventors of record are Stephen Madigan, Larry Hess, and Cynthia Hess.

Ms. Hess states the delay in payment of the fee was "unavoidable because of the divorce of two of the inventors." Ms. Hess states the patent information was in the possession of the divorce attorneys and that the patentees were unaware of the deadline. Ms. Hess also states, "Mail is being sent to different locations, so the deadline was not communicated properly."

Discussion

35 U.S.C. § 41(c)(1) states, with emphasis added, "The Director may accept the payment of any maintenance fee . . . after the six month grace period if the delay is *shown to the satisfaction of*

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*the Director* to have been unavoidable.” Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. A petition will not be granted if petitioner provides insufficient evidence to “show” that the delay was unavoidable.

In order for a party to show unavoidable delay, the party must show “reasonable care was taken to ensure that the maintenance fee would be promptly paid.”<sup>1</sup> The level of “reasonable care” required to be shown is the same as the level of “care or diligence ... generally used and observed by prudent and careful men in relation to their most important business.”<sup>2</sup> When determining if a period of delay has been shown to have been unavoidable, the Office will take “all the facts and circumstances into account” and will decide each petition “on a case-by-case basis.”<sup>3</sup>

The Office has reviewed the record and determined the petition fails to demonstrate the entire delay in payment of the maintenance fee was unavoidable.

37 C.F.R. § 1.378(b) requires a party to “enumerate the steps taken to ensure timely payment of the maintenance fee.” In other words, a failure by a party to take, or obligate another party to take, steps to ensure timely payment of maintenance fees, will “preclude acceptance of the delayed payment of the maintenance fee under 37 C.F.R. § 1.378(b)(3).”<sup>4</sup> The petition fails to identify any steps taken to ensure the 3.5 year maintenance fee would be timely paid. Therefore, the petition cannot be granted.

Ms. Hess states the patent information was in the possession of the divorce attorneys. However, Ms. Hess fails to fully identify the specific patent information in the possession of the attorneys or describe how their possession prevented her or any other inventor from timely paying the maintenance fee.

Ms. Hess states, “[T]he deadline was not communicated promptly.” Ms. Hess *may* be seeking to argue the delay was unavoidable, at least in part, because of a failure by Ms. Hess to receive a maintenance fee reminder. However, delay resulting from a failure to receive a maintenance fee reminder is not unavoidable delay.<sup>5</sup> Therefore, delay resulting from a failure by Ms. Hess to receive a maintenance fee reminder was not unavoidable delay.

For the reasons above, the showing of record is not sufficient to establish that the entire delay was unavoidable within the meaning of 37 C.F.R. § 1.378(b) and the petition is dismissed.

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<sup>1</sup> 37 C.F.R. § 1.378(b).

<sup>2</sup> *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). See also *Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) (“[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.”)

<sup>3</sup> *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

<sup>4</sup> Manual of Patent Examining Procedure (“MPEP”) § 2590 (8th ed., Rev. 8, July 2010).

<sup>5</sup> See *Ray v. Lehman*, 55 F.3d 606, 609; 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995).

Even if the showing of record demonstrated the entire delay in submission of the fee was unavoidable, the petition could not be granted. A review of the record indicates the petition is only signed by Ms. Hess, one of the four inventors. All future papers filed in this case must include the signatures of all the inventors. Ms. Hess should feel free to call the telephone number at the end of the instant decision with respect to any questions she may have regarding the signatures which must appear on future papers.

### Petitioner's Current Options

#### I. Petitioner may file a request for reconsideration.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 C.F.R. § 1.17. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.378(b)."

*After a decision on the petition for reconsideration is issued, no further reconsideration or review of the matter will be undertaken by the Director.* Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

#### II. Petitioner may wish to file a petition under 37 C.F.R. § 1.378(c).

Petitioner may wish to consider filing a petition to reinstate the patent based on unintentional expiration under 37 C.F.R. § 1.378(c). In general, a petition under 37 CFR 1.378(c) needs to simply state that expiration of the patent was "unintentional," whereas a petition under 37 CFR 1.378(b) must prove that the entire delay in payment was "unavoidable." The surcharge for an unintentional petition under 37 C.F.R. § 1.378(c) is \$1,640. Therefore, if a petition under 37 C.F.R. § 1.378(c) is filed, it must be accompanied by a payment of \$940.

A copy of a blank petition form PTO/SB/66 is enclosed for petitioner's convenience. As an alternative to writing a check, or mailing a money order, petitioner may pay the required additional funds by credit card. A credit card authorization form is enclosed for petitioner's convenience.

#### III. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Since the petition is dismissed, petitioner may request a refund of the maintenance fee and surcharge. Petitioner is reminded that if a request for reconsideration is later filed along with the

\$400 fee, the \$400 will not be refunded. A request for a refund should be sent to: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany any request for refund.

Further correspondence with respect to this matter may be submitted as follows:

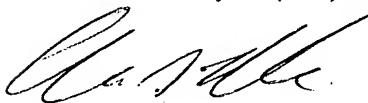
By Internet: A request for reconsideration may be filed electronically using EFS Web.<sup>6</sup>  
Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300  
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley  
Senior Petitions Attorney  
Office of Petitions

Attachments: Form PTO/SB/66 (petition form)  
Form PTO-2038 (credit card form)

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<sup>6</sup> General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.